

OCT 01 2004
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IFW

In Re Application of: Solomon WASSER

Application No.: 10/705,196

Conf. No.2921

Filed: November 12, 2003

For: SUBSTRATE AND METHOD FOR GROWING SHIITAKE MUSHROOMS *LENTINUS*
EDODES (BERK.) SINGER AND NEW SHIITAKE STRAIN

THE COMMISSIONER OF PATENTS
2011 South Clark Place, Mail Stop
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Transmitted herewith is a [XX] Response to Restriction Requirement [] _____
in the above-identified application.

[XX] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

[XX] No additional fee is required.

[] The fee has been calculated as shown below:

	(Col. 1) CLAIMS REMAINING AFTER AMENDMENT	(Col. 2)	(Col. 3) HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

ADDITIONAL FEE TOTAL

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 44	\$
+ 150	\$
ADDITIONAL FEE TOTAL	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 88	\$
+ 300	\$
TOTAL	

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [] First - \$ 55.00
- [] Second - \$ 215.00
- [] Third - \$ 490.00
- [] Fourth - \$ 765.00

Month After Time Period Set

[] Less fees (\$_____) already paid for ____ month(s) extension of time on _____.

Other Than Small Entity

Response Filed Within

- [] First - \$ 110.00
- [] Second - \$ 430.00
- [] Third - \$ 980.00
- [] Fourth - \$ 1530.00

Month After Time Period Set

[] Please charge my Deposit Account No. 02-4035 in the amount of \$_____.

[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$_____.

[] A check in the amount of \$_____ is attached (check no.).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

By: 
Sheridan Neiman
Registration No. 20,520



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: WASSER1

In re Application of:) Confirmation No.: 2921
)
 Solomon WASSER et al) Art Unit: 3643
)
 Appln. No.: 10/705,196) Examiner: J.L. GELLNER
)
 Filed: November 12, 2003) Washington, D.C.
)
 For: SUBSTRATE AND METHOD FOR) October 1, 2004
 GROWING SHIITAKE ...)
)

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir :

Applicants are in receipt of the Office action
mailed September 3, 2004, entirely in a nature of a requirement
for restriction, and applicants hereby reply thereto.

Restriction has been required among what the PTO
considers to be three (3) patentably distinct inventions. As
applicants must make an election even though the requirement is
traversed, applicants hereby respectfully and provisionally
elect Group I, presently comprising claims 1-13, directed to a
substrate comprising olive oil waste as a nutrient for the
growth of edible and medicinal shiitake mushrooms, with
traverse and without prejudice.

The PTO position is that Group II (the method which employs the substrate of elected Group I) can be practiced using a different substrate, i.e. newspaper with fertilizer. Respectfully, this is not correct. Thus, the main claim of a non-elected Group II, i.e. claim 14, the subject matter of which is incorporated into all of the Group II claims, specifically recites growing the mushrooms "on a sterilized substrate containing olive oil waste as the nutrient." To say that the process "as claimed" can be carried out using another substrate is to ignore what is recited in the method claims 14-30, which is of course fundamentally inconsistent with claim construction, i.e. it is a fundamental principle of patent law that all words which appear in a claim are to be given full consideration.

To reiterate this point, inventions II and I are related to a single invention, because the method for production of shiitake mushrooms of claims 14-30 comprises growing the mushroom aseptically on the sterilized substrate containing olive oil waste of claims 1-13. Thus, unity of claims 1-30 as comprising one invention stems from the fact that the method of the invention is performed **essentially** with the use of the substrate of the invention, namely olive oil waste as a nutrient. Indeed, it is desirable according to the present invention that there be no other nutrient.

As between Groups I and III, please note that claim 1 specifies *Lentinus edodes*. Applicants respectfully maintain that inventions I and III constitute a single invention because the new shiitake strain, Ile-1, grows faster and in higher yields as compared to other varieties when grown on that particular substrate.

As regards Groups II and III, applicants respectfully submit that inventions II and III constitute a single invention, since the method defined in claims 14-30 produces significantly higher yields of Ile-1.

Applicants respectfully request the examiner to carefully review the claims. Applicants believe that there may be some confusion in the PTO in view of the language used in the restriction requirement Office action. Such language with reference to "apparatus" seems very strange to applicants, and is inaccurate. The substrate for growing mushrooms is NOT an "apparatus" and the method of growing mushrooms using this substrate is NOT a "process practiced by this apparatus". The new and unique substrate for growing shiitake mushrooms provided by the present invention is not "an apparatus", but rather a product which constitutes a unique and essential element in the proposed method for growing said mushrooms. The method, as defined in the present application, cannot be performed without this essential element.

In addition to the reasons presented above as to why the restriction requirement should be withdrawn, there is another important reason as set forth in the second paragraph of MPEP §803, which **requires** the search and examination of an entire application (or at least plural groups), even when the restriction requirement is correct, if it would not constitute a "serious burden" to do so. In the present case, the elected substrate claims of Group I specify the mushroom species, and the Group II claims require the substrate of the elected Group I claims. Under these circumstances, a complete search of the elected substrate would **require** searching at least the method of growing mushrooms of Group II, which in turn requires consideration of the Group II claims.

Accordingly, once such Group II claims have been considered and searched as part of a complete search of the elected Group I claims, as required by 37 C.F.R. §1.104(a)(1), it would not constitute a serious burden to examine also the Group II claims. Accordingly, applicants respectfully request withdrawal of the requirement and examination of all the claims on the merits.

Applicants now respectfully await the results of a first examination on the merits. Based on the prior art of which applicants are aware, noting the IDS of record, applicants believe that their claims define patentable subject

Appln. No. 10/705,196

Reply dated October 1, 2004

Reply to Restriction Requirement of September 3, 2004

matter; accordingly, based on such known prior art, applicants respectfully request favorable consideration and allowance.

Respectfully submitted,

BROWDY AND NEIMARK
Attorneys for Applicant(s)

By:


Sheridan Neimark
Reg. No. 20,520

SN:jab
624 Ninth Street, N.W., Suite 300
Washington, D.C. 20001-5303
Telephone: (202) 628-5197
Facsimile: (202) 737-3528
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